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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
MALLARI, PATRICIA C	

ART UNIT	PAPER NUMBER
3735	

MAIL DATE	DELIVERY MODE
11/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/709,183	VERMEULEN ET AL.	
	Examiner	Art Unit	
	Patricia C. Mallari	3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 August 2007*.

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-50* is/are pending in the application.

4a) Of the above claim(s) *1-23,32-34 and 41-50* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-26,29-31,35 and 38-40* is/are rejected.

7)☒ Claim(s) *27,28,36,37* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This is a non-final Office action. The indicated allowability of claims 26 and 29-31 has regretfully been withdrawn. See the rejection below for details.

Response to Amendment

The amendment filed 5/24/07 was received and entered. Applicants' response to the restriction requirement filed 8/29/07 was also received and entered.

The declaration filed on 2/14/07 under 37 CFR 1.131 has been considered but is ineffective to overcome the Pruche reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Pruche reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). MPEP 2138.04 states that conception has been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without "exercise of the inventive faculty". The evidence fails to show at least, but not exclusive to, the indicator being reactive with at least one substance found on the skin, activating the flowable indicator through a reaction of the indicator with the at least one substance found on the skin after a period of time to effect a visually discernable change of the flowable indicator, or comparing the visually discernable change of the

indicator to a reference to characterize skin condition. One of ordinary skill in the art would be unable to reduce to practice the claimed invention without this information without exercise of inventive faculty. Page 4 of Exhibit A, for example, merely states, "Camelion is an indicator that changes its color depending on the level of ____ oil, which is naturally secreted from the hair follicles on your scalp and facial areas". The exhibit fails to clearly mention, show, or describe that a reaction occurs between at least one substance found on the skin and the indicator, nor is any time period included after which activation occurs. Page 5 of Exhibit A shows a labeled scale, but fails to demonstrate comparing the visually discernable change of the activated flowable indicator to a reference to characterize skin condition. Exhibits B, C, D, F, and G fail to address any specifics of the invention. Although exhibit E contains a summary of the invention, again, the evidence provided therein lacks any mention, showing, or description of a reaction occurring between a substance found on the skin and the indicator, nor of a time period after which activation occurs. The exhibit further lacks comparing a visually discernable change in the indicator to a reference to characterize skin condition. Exhibit H mentions a reaction with oil, but does not address the oil being oil found on the skin, nor does the exhibit address a period of time after which activation occurs. The exhibit further lacks comparing a visually discernable change in the indicator to a reference to characterize skin condition. Exhibit I also discusses oil and a mask system, but lacks mention, showing, or description of a reaction occurring between a substance found on the skin and the indicator and of a period of time, after which, activation occurs. The exhibit further lacks comparing a visually discernable

change in the indicator to a reference to characterize skin condition. Exhibit J is merely a prior art listing of cosmetic colors and Exhibit K is merely an invoice for the ordering of dyes. Again, neither exhibit addresses a reaction between a substance found on the skin and the indicator nor a period of time after which activation occurs. The exhibits further lack comparing a visually discernable change in the indicator to a reference to characterize skin condition.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Pruche reference. As described above, the evidence submitted in Exhibits A-K fails to show at least, but not exclusive to, the indicator being reactive with at least one substance found on the skin and activating the flowable indicator through a reaction of the indicator with the at least one substance found on the skin after a period of time to effect a visually discernable change of the flowable indicator. The evidence further lacks any indication of comparing a visually discernable change in the activated indicator to a reference to characterize skin condition. Therefore, an actual reduction to practice of the invention also has not been shown.

Election/Restrictions

Applicant's election with traverse of Group II in the reply filed on 8/29/07 is acknowledged. The traversal is on the ground(s) that the examiner has allegedly "not met the burden of establishing (A) separate classification, (B) separate status in the art when inventions are classifiable together or (C) a different field of search. This is not

found persuasive with respect to the method and apparatus claims because at least a different search (i.e. different search queries) is required for each enumerated group. Applicants have stated, "It follows that a different field of search is not required as a search for one invention would likely result in finding art pertinent to the other inventions, especially considering the same classification of the inventions". However, this is not so. Because of the difference in nature between a method and an apparatus, a different search strategy is required for each of the method and the apparatus, because of the difference in nature between a method and apparatus. Moreover, examination of the different groups presents further burden on the examiner, since one group is an apparatus and another a method.

The restriction requirement between Groups I and II is still deemed proper and is therefore made FINAL.

On the other hand, the restriction by original presentation has been withdrawn, which restriction amounted to a restriction between the indicator (subcombination) and the system including such an indicator (combination), particularly as claims 18 and 19 operate as linking claims linking the two groups together. Therefore, non-elected group I, drawn to the apparatus (indicator or system including such indicator), includes claims 1-23, 32-34, and 41-50.

Claims 1-23, 32-34, and 41-50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 24, 29, 30, 31, 38, 39, and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application Publication No. 2003/0108542 to Pruche et al. Regarding claims 24, 29, 30, 31, 38, 39, and 40 Pruche discloses a method of employing a flowable indicator for characterizing skin condition comprising, wherein the flowable indicator G is applied to a desired area of skin P and wherein the indicator is reactive with at least one substance found on the skin (see entire document, especially fig. 2; paragraphs 8, 14, 69-72 of Pruche). The flowable indicator is activated through a reaction of the indicator with the at least one substance found on the skin after a period of time to effect a visually discernable change of the flowable indicator (see entire document, especially paragraphs 70 and 87 of Pruche). The visually discernable change of the indicator is compared to a reference to characterize skin condition (see entire document, especially fig. 16; paragraphs 94-96 of Pruche).

With further regard to claims 29, 31, 38, and 40, appropriate cosmetics are determined for use with the characterized skin condition (see entire document, especially paragraphs 25-27 of Pruche).

With further regard to claims 30, 31, 39, and 40, a visual reference is provided for comparison of the visually discernable change o the indicator to a standardized reference point to determine skin condition (see entire document especially paragraphs 94-96 of Pruche).

Claims 24-26 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,489,510 to Lopukhin et al. Regarding claims 24-26 and 35, Lopukhin teaches a method of employing a flowable indicator for characterizing skin condition, wherein the flowable indicator is applied to a desired area of skin, the indicator being reactive with at least one substance found on the skin (see entire document, especially col. 4, lines 12-63 of Lopukhin). The flowable indicator is activated through a reaction of the indicator with the at least one substance after a period of time to effect a visually discernable change of the flowable indicator (see entire document, especially col. 4, lines 12-35 and lines 40-54 of Lopukhin). The visually discernable change of the indicator is compared to a reference to characterize skin condition (col. 4, lines 24-35; col. 4, line 43-col. 6, line 22 of Lopukhin), wherein, for example, the reference may be the control spot or the disclosed information that the number of spots exhibiting a color change corresponds to the skin type.

With further regard to claims 25, 26, and 35, the user waits for the indicator to activate (see entire document, especially col. 4, lines 22-27, lines 40-47 of Lopukhin).

With further regard to claims 26 and 35, monitoring the control spot/drop (see entire document, especially col. 4, line 63-col. 5, lines 22 of Lopukhin), constitutes a determination of whether the indicator is activated.

Allowable Subject Matter

Claims 27, 28, 36, and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Regarding claims 27, 28, 36, and 37 the primary reason for allowance is the inclusion of the further step of waiting for the flowable indicator to activate it the user has determined that the flowable indicator is not yet activated, in combination with all of the other limitations of the claims, which is not found in the prior art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia C. Mallari whose telephone number is (571) 272-4729. The examiner can normally be reached on Monday-Friday 10:00 am-6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert L. Nasser/
Primary Examiner, Art Unit 3735

/P. C. M./
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